

REMARKS

This application has been reviewed in light of the Office Action dated November 20, 2009. In view of this amendment, Claims 1-9 were pending in this case. Claim 1 is independent. Claim 1 has been amended.

Rejection Of Claims Under 35 U.S.C. § 102(b)

Claims 1-7 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,641,391 (hereinafter "Hunter et al."). Hunter et al does not teach or suggest all of the steps of amended independent claim 1. More particularly, Hunter et al. does not teach the steps of "providing the substrate and at least one nanoscale electrode, the substrate and the nanoscale electrode oriented substantially perpendicular to each other" and "at least partially inserting the nanoscale electrode and the substrate substantially vertically into the electrolyte." Support for these claim amendments may be found in FIG. 9 and paragraph [0053] of the application as published in the US (US 2006/0249391 A1). All embodiments of the invention described in Hunter et al., including FIGS. 1-3 and the specification show and describe a substrate immersed in a bath oriented horizontally and the electrode(s) oriented perpendicular to the substrate and immersed in the bath horizontally. In the present invention claimed in amended independent claim 1, the substrate and the electrode are dipped vertically into the bath.

As such, Hunter et al. does not disclose, suggest, or render obvious each and every element of amended independent claim 1. Therefore, claim 1 has been shown to be patentable over Hunter et al. Applicant respectfully requests that the 35 U.S.C. §102(b) rejection of amended independent claim 1 be withdrawn. Each of pending claims 2-7 ultimately depend from claim 1. Since claim 1 has been shown to be patentable, dependent claims 2-7 are

likewise deemed to be patentable, for at least the reasons described above with respect to the patentability of amended claim 1. Applicants respectfully request that the 35 U.S.C. §102(b) rejections of claims 2-7 be withdrawn.

Rejection Of Claims Under 35 U.S.C. § 103(a)

Claims 8-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of U.S. Patent No. 6,831,017 (hereinafter "Li et al.").

Li et al. fails to correct all of the deficiencies of Hunter et al. Like Hunter et al., all of the substrates are oriented in a horizontal plane with the nanostructures oriented vertically to the substrate. Li et al. does not teach, suggest, or render obvious the steps of "providing the substrate and at least one nanoscale electrode, the substrate and the nanoscale electrode oriented substantially perpendicular to each other" and "at least partially inserting the nanoscale electrode and the substrate substantially vertically into the electrolyte." As such, Li et al., alone or in any hypothetical combination with Hunter et al. does not disclose, suggest, or render obvious each and every element of amended independent claim 1. Therefore, claim 1 has been shown to be patentable over Hunter et al. in view of Li et al. Each of pending claims 8-9 ultimately depend from claim 1. Since claim 1 has been shown to be patentable, dependent claims 8-9 are likewise deemed to be patentable, for at least the reasons described above with respect to the patentability of amended claim 1. Applicants respectfully request that the 35 U.S.C. §103(a) rejections of claims 8-9 be withdrawn.

Thus, Applicant submits that each of the claims of the present application is patentable over the reference of record. Accordingly, withdrawal of the rejections to the claims is respectfully requested.

CONCLUSION

No fee is believed to be due in connection with the present. If, however, other fees are deemed necessary for this Amendment to be entered and considered by the Examiner, then the Commissioner is authorized to charge such fee to Deposit Account No. 501358.

Applicant's undersigned agent may be reached by telephone at (973) 597-2500. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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